

REMARKS

This is in response to the Examiner's Office Action dated April 11, 2007. Reconsideration of this Office Action is hereby requested in view of the above amendments and remarks which follow.

The Examiner rejected claims 1-23 under 35 U.S.C. § 103a as being unpatentable over Taylor, et al. (U.S. Patent 5,262,710) in view of Slipy, et al., U.S. Patent No. 5,955,700. Applicant respectfully urges that independent claim 1 is patentably distinguishable from the applied reference Taylor, et al. in combination with Slipy, et al., as the claimed subject matter would not have been obvious within the meaning of 35 U.S.C. § 103(a).

The Examiner indicated that as to claims 1 and 13, that Taylor teaches a housing (106) having a battery (420) receiving cavity, the cavity being profiled to receive at least a battery therein (Figure 5); electrodes (224) for contacting contacts on the battery (420) (Col. 9, lines 52-54) for charging the battery (Col. 9, lines 27-31); a gripping member (280 and 290) movable between a locked (386 and 392) and unlocked (498, 504) position, for gripping a battery placed within the cavity (Col. 10, lines 27-32). The Examiner admits that Taylor does not teach the housing comprising an opening through the housing and into the cavity, nor that a gripping member is movable transversely into and out of the housing opening.

Rather, the Examiner indicated that Slipy teaches a housing (302) having a battery (112) receiving cavity (128), the housing (302) comprising an opening through the housing (302) and into the cavity (128) (referring to column 5, lines 20-24). The Examiner indicates that Slipy teaches a gripping member (106) which is movable transversely into and out of the housing opening referring to column 5, lines 17-20. Thus the Examiner indicated that it would have been obvious to one of ordinary skill in

the art at the time the invention was made to have had a housing comprising an opening through the housing and into a battery receiving cavity and a gripping member movable transversely into and out of the housing opening in Taylor as taught in Slipy because it is known in the art as an expected successful configuration of gripping member and battery housing.

Applicants believe that Slipy, et al. does not show a gripping member movable transversely into and out of the housing opening. Applicants' claim 1 indicates that the "housing further comprising an opening through said housing and into said cavity". Rather Slipy shows a battery compartment at 128 which is remote from any area where latching mechanism (106) exists. Thus the latching mechanism (106) does not move transversely into and out of a housing opening which communicates with the cavity but rather is journaled on semi-circular notches (150 and 160) and rotates between multiple positions shown in Figures 4-6. Moreover, Slipy has nothing to do with moving between a locked and unlocked position for gripping the battery placed within the cavity but rather holds door cover (102).

Moreover, the Slipy cam is used to urge the door 102 open, not closed. As discussed in Slipy, Column 3, lines 57-61, "Cam 206 has a cam diameter greater than the circular opening diameter of the circular opening formed by semicircular notches 152 and 162." And in Column 4, lines 52-64, Slipy indicates that "[b]attery door 102 may be detached from the housing unit 302 as follows. ... The instrument is rotated to rotate latching mechanism 106 in a counterclockwise direction...[and c]am surface 216 contacts and urges latch 108 outwards from opening 164 as in Figure 5."

In determining the issue of obviousness, one must look to the collective teachings of the references into whether the hypothetical person of ordinary skill in the art, familiar with such teachings, would have found it obvious to make a structure corresponding to that which is claimed. *In re Keller*, 642 F.2d 413, 425, 208 U.S.P.Q.

871, 881 (CCPA 1981); *In re Sernaker*, 702 F.2d 989, 994, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). Moreover, "it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious," meaning hindsight reconstruction to pick and choose among isolated disclosures in the prior art in order to disapprove of the claimed invention is improper. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q. 2d, 1780, 1783-1784 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

M.P.E.P. § 2143; see also *In re Royka*, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Moreover, even if the combination of references teach every element of the claimed invention, a rejection based on a *prima facie* case of obviousness is improper without a motivation to combine. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1457-58 (Fed. Cir. 1998).

Furthermore, claim 1 is not obvious as "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not in applicant's disclosure." M.P.E.P. § 2143 (emphasis added); citing *in re Vaeck*, 947 F. 2d 488, 20 U.S.P.Q. 2d 1433 (Fed. Cir. 1991).

Nor is the above doctrine overruled by the recent U.S. Supreme Court case, *KSR International Company v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In fact, the Supreme Court indicated that "there is no necessary inconsistency between the idea underlying the TSM (Teaching Suggestion Motivation) test and the Graham analysis."

And in a letter dated May 3, 2007 from Margaret Focarino, she instructed the Technology Center Directors to the following guidance when rejecting patent claims under 35 U.S.C. §103(a),

The Court did not totally reject the use of "teaching, suggestion or motivation" as a factor in the obviousness analysis. Rather the Court recognized a showing of "teaching, suggestion or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. §103(a).

.....

The Court noted that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relative field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often it will be necessary...to look to interrelated teachings to multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.** (Emphasis Original).

She closes by indicating that "in formulating rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior elements in the manner claimed."

The reasoning suggested above does not exist here, because the two prior art references are inconsistent in their teachings, and even if combined, would not results in Applicant's claimed invention. While Taylor shows a battery charger assembly, the battery as shown at 420 in Figure 3 simply slides into a notch (362). Nothing in Taylor latches the battery in place. On the contrary, Slipy, et al. shows a cell phone, not a

charger. Slipy shows only a latching member to latch the battery cover (102), when the latch is remote from the battery compartment and does not move transversely through the housing opening into the battery compartment. Nor does Slipy have a cam operated gripping member as indicated by the Examiner. Actually the Slipy cam works in an opposite manner as in the present invention.

Namely, the Slipy cam is used to urge the door 102 open, not closed. The Slipy cam 206 has a diameter greater than the circular opening diameter of the circular opening formed by semicircular notches 152 and 162, therefore, when rotated, pushes against latch 118, and detaches the battery door 102 from the housing unit 302. The cam surface 216 contacts and urges latch 108 outwards from opening 164 as in Figure 5.

Applicants believe that the Examiner, in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, needs to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. However, as Applicants have pointed out, the prior art references expressly teach why the prior art elements - would not, and could not - have been combined in the manner asserted by the Examiner.

The Examiner also rejected claim 2 indicating that it was known to have a gripping member moved by a cam assembly. As mentioned above, Slipy does not move the gripping member rather it moves the housing out of the cell phone. The Examiner also rejected claim 3 although no reference shows a gripping member moveable transversely into and out of a housing where the gripping member is comprised of a gripper portion attached to an insert. The Examiner also rejected claim 4 indicating that Slipy shows a rotatable cam, however as mentioned above, this cam does not act to grip the battery but rather to open the cell phone cover. The Examiner rejected claim 5 although as mentioned in claim 3, no reference shows a gripper

member which is moveable transversely and has a rubber-like material molded to a plastic insert. The Examiner indicates that Slipy teaches a gripper member with a rubber-like material integrally connected to a plastic insert. This is a mischaracterization of Slipy. Slipy indicates that the gripper member is plastic at Column 3, lines 9-11 and in fact, the entire member 202 is a molded plastic member. There are no such rubber-like material elements attached to an insert in Slipy.

The Examiner rejected claim 6 now indicating that Taylor includes a U-shaped insert with like portions 296 and 302. However as to claim 1, the Examiner indicated that Taylor does not specifically teach a gripping member moving transversely into and out of the housing opening, and for that reason combined Slipy. Claim 6 cannot be read in a vacuum without incorporating the limitation into claim 1. Thus Taylor does not teach a U-shaped gripping member moveable into and out of the housing. The same rationale applies as to claim 7.

As to claims 8 and 9 where the cam and the follower groove are contoured for a nested and detented position, respectively, nothing in Slipy shows contour for such positions. Rather the element 202 simply rotates within its semicircular grooves to locked and unlocked positions. The Examiner shows Figure 6 as indicating a detented position, however this is simply for the locked position not a detented position.

As to claim 10, Taylor does not show a battery receiving cavity profiled to receive the battery connected to its handheld appliance. As to claim 11, the Examiner indicates that Taylor teaches guides 362 and 368, however these guides as referred to by the Examiner are on the same element which the Examiner previously referred to as to the gripping members. Finally, as to claim 12, the Examiner indicates that Slipy teaches a battery receiving cavity including guide grooves, however as mentioned above, Slipy merely shows a cell phone for receiving batteries for the operation of the cell phone not

Appl. No. 10/757,146
Amdt. Dated June 7, 2007
Reply to Office Action of April 11, 2007

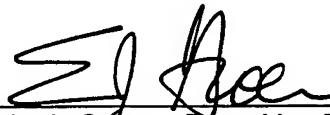
a battery charger as defined in dependent claim 12 incorporating all of the limitations of the intermediate claims.

As to claims 14-23, the same arguments apply as to dependent claims 2-12.

Given all of the amendments and remarks, Applicants believe that claims 1-17 are in condition for allowance and respectfully request early passage thereof.

If necessary to effect a timely response, please consider this paper a request for an extension of time, and charge any shortages in fees, or apply any overpayment credits, to Baker & Daniels' Deposit Account No. 02-0387 (72249.90053). However, please do not include the payment of issue fees.

Respectfully submitted,



Eric J. Groen, Reg. No. 32,230
Baker & Daniels
300 North Meridian, Suite 2700
Indianapolis, IN 46204
Telephone: (317) 237-1115
Fax: (317) 237-1000

I hereby certify that this correspondence
is being deposited with the U.S. Postal Service as
First Class Mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450 on

June 7, 2006
Date



Eric J. Groen, Reg. No. 32,230